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10/582,426

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George Gallagher

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EXAMINER

MEHTA, BHISMA

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/582,426	<b>Applicant(s)</b> GALLAGHER, GEORGE	
	<b>Examiner</b> BHISMA MEHTA	<b>Art Unit</b> 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-35, 41, and 42 is/are rejected.
- 7) ☒ Claim(s) 36-40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings were received on January 12 2009. These drawings are acceptable as to the changes made in Figure 6.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rotary member must be shown or the feature(s) canceled from the claim(s). Also, the bearing with a pointed inner profile, a flat inner profile with a chamfered inner race, and each bearing being angled with respect to the shaft such that it contacts the shaft in at least two points must be shown or the feature(s) canceled from the claim(s). The automatic means for reversing direction of travel of the bearings and the actuator along the shaft and the adjustable biasing means must be shown or the feature(s) canceled from the claim(s) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Applicant's arguments in line 23 of page 11 to line 13 of page 12 have been considered but are not persuasive. It is unclear what is meant by the features shown in Figure 1 setting forth a graphical symbol illustrating the rotary member as no graphical symbol is seen which represents the rotary member. In addition, it is also unclear how the invention, which is drawn to a shaft, at least one bearing, and an actuator as set forth in claim 1 in addition to the rotary member of claim 2, can be shown with a shaft, at least one bearing, and an actuator which combined is a symbol of the rotary member. Similarly, the bearings as noted above are not shown in

the figures and it is not clear how a graphical symbol has been provided for the bearings.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The disclosure is objected to because of the following informalities:

It is the Examiner’s position that Applicant has invoked sixth paragraph, means-plus-function language to define Applicant’s invention. Therefore the Examiner requires the Applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP

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608.01(o) to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, and acts perform the function recited in the claim element. Please note that the MPEP clearly states, "Even if the disclosure implicitly sets forth the structure, materials, or acts corresponding to the means-(or step-) plus-function claim element in compliance with 35 U.S.C. 112, first and second paragraphs, the PTO may still require the applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP 608.01(o)...". (Also see **MPEP 2181** (Rev. 1, Feb.2000)).

It should be noted that the specific amendments made to lines 2-3 of page 3 and to lines 14-16 of page 5 as indicated in the remarks have not been made in the replacement sheets of the specification. Applicant is requested to check all of the amendments made in the replacement sheets as some inconsistencies between the indicated amendments and the actual amendments made in the replacement sheets have been noticed. For example, the word "of" in paragraph 3 of page 10 has not been deleted in line 1 of paragraph [0037] of the amended specification (as seen in the replacement sheets). Similarly, there is an omission of the word "by" in line 10 of page 12 of the original specification (see line 7 of paragraph [0042] of the amended specification).

Appropriate correction is required.

4. The disclosure is objected to because of the following informalities: There is a grammatical error in the phrase "be moveable my means of" in line 1 of page 12 of the original specification.

Appropriate correction is required.

***Claim Objections***

5. Claims 37-42 are objected to because of the following informalities: It is the Examiner's position that Applicant has evoked sixth paragraph, means-plus-function language to define Applicant's invention. Therefore the Examiner has objected to the claims for the reasons set forth above in the objection to the specification. Appropriate correction is required.

6. Claims 23, 24, 27-40, and 42 are objected to because of the following informalities: There appears to be a grammatical error in the phrase "by a rotary member at least one point along the length" in claim 23. In claims 27, 28, 33, 34, 40, and 42, it is unclear which bearing is being referred to with the recitation of "the bearing". There appears to be a grammatical error in the phrase "it contacts the shaft at least two points" in claim 29. Claim 23 recites the limitations "the length" in line 3. Claim 30 recites the limitations "the other of the outer bearing" in line 2 and "the central bearing" in lines 3-4. Claim 32 recites the limitations "the inclined bearings" in lines 1-2, "the shaft axis" in line 2, and "the outer races of the bearings" in line 3. Claim 38 recites the limitations "the spring mechanism" in lines 2-3. There is insufficient antecedent basis for these limitations in these claims. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 22-32, 41, and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Dumore Company (FR 1.562.416).

Dumore Company disclose an assembly with a motor driven unthreaded shaft (10, 14), at least one bearing (15) mounted obliquely to the shaft, and an actuator (30, 46) linked to at least one of the bearings. In page 8 of the translated document, it is disclosed that there may be more or less than 4 bearings. The assembly also has a rotary member (31). As to claims 25-32, see Figures 6a, 6c and the relevant portions of the specification. As to claim 41, see pages 5 and 6 of the translated document. As to claim 42, the bearing has biasing means (21).

9. Claims 22-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Uhing (U.S. Patent No. 4,253,342).

Uhing discloses an assembly having a motor drive unthreaded shaft (11), at least one bearing (10, 10'), and an actuator 916). As to claims 23 and 24, see Figures 1-3b. As to claims 25-32, see Figure 4. As to claim 33, the bearing is spring loaded as seen in Figure 6. As to claims 34 and 35, the bearing is housed within a carriage (16, 16') and connected to an actuator.

### ***Allowable Subject Matter***

10. Claims 36-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

11. Applicant's arguments filed January 12 2009 have been fully considered but they are not persuasive. In response to applicant's argument in line 7 of page 13 to line 9 of page 16 that the assembly of Dumore Company and the assembly of Uhing are not related to the medical device art, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Also, Applicant's arguments that the assembly of Dumore Company relates to industrial technology and has no teaching of being applied to medical devices are not relevant as the assembly of Dumore Company has the claimed structural features. Furthermore, the actuator of Dumore Company is seen to be capable of having contact with a thumbplate of a syringe plunger. The references to the International Preliminary Report on Patentability are unclear as the examination of the present application is not based on the same requirements and rules as those applied in the International Preliminary Report. Applicant's arguments that the assembly of Uhing relates to industrial technology and does not relate to medical devices are not relevant as the assembly of Uhing has the claimed structural features.

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BHISMA MEHTA whose telephone number is (571)272-3383. The examiner can normally be reached on Monday through Friday, 7:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on 571-272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bhisma Mehta/

Examiner, Art Unit 3767

/Kevin C. Sirmons/

Supervisory Patent Examiner, Art Unit 3767